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09/712,915	11/16/2000	Toshiyuki Moritsu	ASA-945	2987

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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,915

Applicant(s)

MORITSU ET AL. *ES*

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 6/15/2000. It is noted, however, that applicant has not filed a certified copy of the 2000-184561 application as required by 35 U.S.C. 119(b).

Claim Objections

3. Claim 14 objected to because of the following informalities: typographical error; change "process or" to "processor" (see lines 5, and 10). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 10, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 4 recites the limitation "the inherent data" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3621

7. Claim 8 and 10 recites the step of corresponding contract data in which said contract content is built with said description data by using said inherent data, wherein said inherent data is description data. How can the contract content be built with said description data using said description data? Please revise this step for clarity.

8. Claim 13 recites the limitation "the inherent data" in line 13. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 15 recites the step of "retrieving description data match to said contract data form description data" implying that the description data is being retrieved from description data. How can the description data be retrieve from description data? Please revise this step for clarity.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2,4, and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed,

Art Unit: 3621

produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to an abstract idea that is not tied to any practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5794207 to Walker et al.

Referring to claim 1, Walker et al. disclose obtaining description data in which a description content presented to one concerned party is built or description specifying data for specifying said description content from the other concerned party of said contract before

Art Unit: 3621

making said contract, generating contract data containing said description data or said specifying data (see Abstract, lines 7-13; col. 8, lines 41-49), and prompting both or either of said concerned parties to write an electronic signature on said contract data (see col. 19, lines 14-15).

Referring to claims 2 and 3, Walker et al. disclose receiving a question or request for said commodity or service from a covenantee who intends to conclude said contract through a network (see col. 8, lines 44-58), adding to a response to said question or request a covenanter's proof that said covenanter's proof that said covenanter created said response, sending said response with said covenanter's proof added thereto to said covenantee through the network, storing said response with said covenanter's proof added thereto in at least one of storage units of said covenanter, said covenantee, and a third party (see col. 19, lines 14-67; col. 20, lines 1-4), if said contract is concluded between said covenanter and said covenantee, creating an electronic contract with which said response with said covenanter's proof added thereto is made to correspond; wherein said response with said covenanter's proof added thereto includes a covenantee's proof that said covenantee agrees with said response (see col. 13, lines 39-44).

Note. The buyer creates a conditional purchase offer (CPO) that includes the buyer's ID and name. When the seller accepts the CPO, a contract is generated including the buyer's ID and name (i.e. "covenantee's proof").

Referring to claim 6, Walker et al. disclose sending a question or request for provision of said commodity or service to a provider of said commodity or service through a network, receiving a response to said question or request from said provider through the network (see col. 8, lines 44-61; col. 14, lines 8-11), adding an electronic signature of said person who accepts said commodity or service to said response and then sending said response to said provider through

Art Unit: 3621

the network, storing said response with the electronic signature of said person who accepts said commodity or service added thereto in at least one of storage units of said provider, said person who accepts said commodity or service and a third party, and if a contract for provision of said commodity or service is concluded between said provider and said person who accepts said commodity or service, storing an electronic contract document on said contract and said response with the electronic signature of said acceptor added thereto as making said electronic contract document correspond with said response (see col. 19, lines 14-67; col. 20, lines 1-4).

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 4, 5, and 7-26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6061792 to Simon.

Referring to claim 4, Simon discloses after a question or request for said commodity or service is received from a covenantee who intends to conclude said contract, outputting a response to said question or request to an output unit of said covenantee, after obtaining the response with an electronic signature of said covenantee added thereto from said covenantor, concluding an electronic contract between said covenantee about said contract (see col. 2, lines 35-45; col. 7, lines 16-20), making the response correspond with said covenantee's electronic signature added thereto with the electronic contract document on said contract by using the inherent data in said response with said covenantee's electronic signature added thereto (see col.

Art Unit: 3621

2, lines 60-64), and storing said electronic contract document in at least one of storage units of said covenanter and said covenantee or providing said covenantee with said electronic contract document recorded on a recording medium (see col. 7, lines 8-10).

Referring to claim 5, Simon discloses adding an electronic signature of said covenanter to the response to be outputted to the output unit of said covenantee (see col. 7, lines 1-8).

Referring to claim 7, Simon discloses creating a hash value of description data in which a description content about said commodity or service having been transferred between the concerned parties before concluding said contract, building said hash value in contract data having said contract content built therein (see col. 5, lines 20-23).

Referring to claims 8-10, Simon discloses a processing unit for creating inherent data in description data in which a description content about a commodity or service is built, said description data having been transferred between the concerned parties about said contract before concluding said contract (see col. 5, lines 1-23; col. 4, lines 20-24), another processing unit for corresponding contract data in which said contract content is built with said description data by using said inherent data; wherein said inherent data is a hash value of said description data; wherein said inherent data is said description data (see col. 4, lines 20-24; col. 5, lines 36-39).

Note. Simon utilizes one computing unit with different modules for performing the steps of claim eight. Although only one unit is being used the features are clearly taught. Also, Simon specifies “that the invention is not limited to the specific features described...” (see col. 7, lines 55-63). Therefore, employing two or more processing units will not depart from the scope of Simon’s invention.

Referring to claim 11, Simon discloses the system wherein said description data contains an electronic signature of at least one of said concerned parties (see col. 2, lines 35-45).

Referring to claim 12, Simon discloses another processing unit for corresponding a description processing program for describing said contract content on an electronic contract document about said contract with said contract data (see col. 4, lines 9-14 and claim 8 note).

Referring to claim 13, Simon discloses a storage unit (see col. 3, lines 55-57), storing description data in which a description content about said commodity or service having been transferred between the concerned parties about said contract is built before concluding said contract (see col. 2, lines 35-47), storing contract data in which said contract content is built (see col. 7, lines 8-10); said description data and contract data being matched to each other by the inherent data in said description data (see col. 5, lines 20-23, 37-39).

Referring to claim 14, Simon discloses a program sending device comprising (see col. 3, lines 25-30) a processor for creating the inherent data in description data in which a description content about a commodity or service having been transferred between the concerned parties about said contract before concluding said contract (see col. 5, lines 1-23), and a processor for matching contract data in which a contract about provision of said commodity or service is built to said description data by using said inherent data (see col. 4, lines 20-24; col. 5, lines 36-39).

Referring to claims 15 and 16, Simon discloses a recording medium comprising (see col. 4, lines 9-11) a process for creating contract data in which said contract content is built (see col. 2, lines 35-42), a process for building inherent data in said retrieved description data in said contract data; herein the process of building the inherent data is executed so that said retrieved description data is served as said inherent data when it is built in said contract data (see col. 20,

Art Unit: 3621

lines 20-23; col. 2, lines 60-64); a process for adding an electronic signature of at least one of said concerned parties to said contract data in which said inherent data is built (see col. 7, lines 1-7). Note, Simon's system adds inherent data in the description data in the contract data; thus, before doing this, the data must first be retrieved. Therefore, the step of retrieving a description data matched to said contract data form description data in which a description content about said commodity or service having been transferred between the concerned parties about said contract is built before concluding said contract is an inherent step.

Referring to claim 17, Simon discloses the recording medium wherein said process for building said inherent data is executed to calculate a hash value of said retrieve description data and to build the hash value of said description data in said contract data as said inherent data (see col. 5, lines 20-23).

Referring to claim 18, Simon discloses determining whether or not either of the electronic signatures of said concerned parties added to said description data is correct and process for adding the electronic signature of the other concerned party to said description data if the electronic signature of one of said concerned parties added to said description data is determined to be correct (see col. 6, lines 61-67; col. 7, lines 1-7).

Referring to claim 19, Simon discloses describing said contract content on an electronic contract document on said contract and a process for building inherent data in said describing program in said contract data (see col. 4, lines 20-24).

Referring to claim 20, Simon discloses a process for building a contract content display template for creating from said contract content a contract content display data to be outputted to an output unit in said contract data (see col. 4, lines 9-19; col. 7, lines 16-20).

Art Unit: 3621

Referring to claim 21, Simon discloses a recording medium wherein said process for writing a signature on said contract data is executed to write said electronic signature on said contract data if a permission for adding said electronic signature to said contract data is received (see col. 7, lines 1-7).

Referring to claim 22, Simon discloses determining if an electronic signature built in said retrieved description data is correct and verifying that said retrieved description content is presented from one of said concerned parties to the other when the contract between said concerned parties is being transferred (see col. 4, lines 20-24; col. 6, lines 61-67; col. 7, lines 16-20). As for retrieving a description content about said contract content from a storage unit for managing description data having the description content about said commodity or service having been transferred between the concerned parties and contract data having said contract content as making said description data correspond with said contract data, before concluding said contract, this is an inherent step. That is, Simon discloses storing a valid contract and printing the contract in case of dispute (see col. 7, lines 7-20), before doing this the contract, which comprises the description, content must first be retrieved from the storage unit.

Referring to claim 23, Simon discloses the hash value of said description data is compared with a value derived by digitizing said electronic signature, for determining said electronic signature is correct (see col. 6, lines 9-22, 61-67). Note. The message signature is authenticated which implies that the contract of the description data and its hash value was also authenticate; hence compared.

Referring to claim 24, Simon discloses obtaining a describing program for enabling concerned parties with said contract to describe a contract content on an electronic contract

Art Unit: 3621

document or specifying data for specifying said describing program, generating contract data containing said describing program or said specifying data and writing an electronic signature of both or either of said concerned parties on said contract data (see col. 4, liens 9-19; col. 2, lines 36-45; col. 7, lines 1-7).

Referring to claim 25, Simon discloses a processing unit for creating inherent data in a describing program for describing a content of said contract on an electronic contract document (see col. 4, lines 20-24; col. 5, lines 1-23), another processing unit for corresponding contract data obtained by describing said contract content on said electronic contract document with said describing program by using inherent data in said program (see col. 5, lines 36-37). Note. Simon utilizes one computing unit with different modules for performing the steps of claim 25. Although only one unit is being used the features are clearly taught. Also, Simon specifies "that the invention is not limited to the specific features described..." (see col. 7, lines 55-63). Therefore, employing two or more processing units will not depart from the scope of Simon's invention.

Referring to claim 26, Simon discloses a recording medium (see col. 4, lines 9-14) comprising a contract content describing process for describing a content of said contract on an electronic contract document, a contract data generating process for generating contract data form an electronic contract document in which said contract content is described (see col. 2, liens 36-45), a program inherent data building process for building inherent data in a describing program for executing said contract content describing process (see col. 4, lines 20-24), a contract data signing process for adding a signature of at least one of concerned parties with said contract to contract data in which said program inherent data is built (see col. 7, lines 1-7).

Art Unit: 3621

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6260024 to Shkedy discloses a system/method for providing a global bilateral buyer driven system for creating binding contracts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications, 703-746-9443 for Non-Official/Draft and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to: **Commissioner of Patents and Trademarks, Washington, DC 20231.**

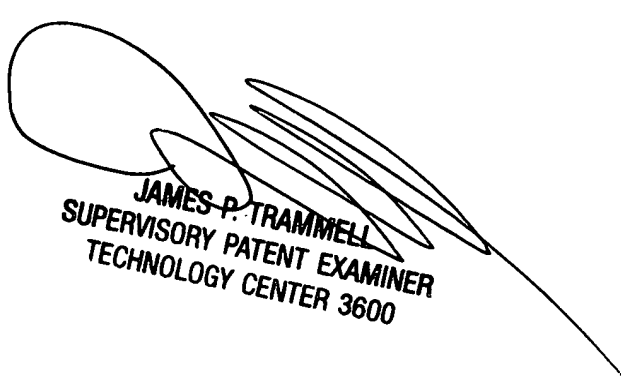
Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

Application/Control Number: 09/712,915

Page 13

Art Unit: 3621

April 30, 2003



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